

REMARKS

Claims 1-20 are pending. Claims 1, 3-6, 8-10, 12, and 14-16 have been amended. Claims 17-20 have been added. No new matter has been introduced. Reexamination and reconsideration of the application are respectfully requested.

In the April 3, 2003 Office Action, the Examiner rejected claims 1-16. The Examiner rejected claims 1-3, 6-8, and 11-14 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,881,131 to Farris et al. ("Farris"), in view of Official Notice. Claims 4, 9, and 15 were rejected under 35 U.S.C. § 103(a) as being obvious over Farris, in view of U.S. Patent No. 6,144,962 to Weinberg et al. ("Weinberg"). Claims 5, 10, and 16 were rejected under 35 U.S.C. § 103(a) as being obvious over Farris, in view of U.S. Patent No. 6,422,523 to Siegel ("Siegel"). These rejections are respectfully traversed.

Embodiments of the present invention relate to a method of searching and reporting an incidence of at least one of a trademark, a tradename, a celebrity name, and a famous name in a Web page on the Internet. A user enters the at least one trademark, tradename, celebrity name, or famous name to be searched in the Web page on the Internet. A search string is automatically created including the at least one trademark, tradename, celebrity name, or famous name based on the at least one trademark, tradename, celebrity name, or famous name entered by the user. A URL address of the Web page on the Internet to be searched is received. Contents of the Web page of the URL address received are accessed and searched for matches in the contents of the Web page corresponding to the search string. The searched contents includes elements other than only a domain name. For example, the searched

contents includes at least two of the following portions of the Web page: a domain name, a meta tag, hidden text, visible text, titles, and images. Search results of identified matches corresponding to the search string in the contents of the Web page of the URL address are provided.

The Examiner rejected claims 1-3, 6-8, and 11-14 under 35 U.S.C. § 103(a) as being obvious over Farris, in view of Official Notice. Claims 4, 9, and 15 were rejected under 35 U.S.C. § 103(a) as being obvious over Farris, in view of Weinberg. Claims 5, 10, and 16 were rejected under 35 U.S.C. § 103(a) as being obvious over Farris, in view of Siegel. The Examiner stated that Farris discloses:

“entering, by a user, the at least one trademark, tradename, celebrity name, and famous name to be searched in the Web page on the Internet (trademark databases and InterNIC and domain names: see [F]ig. 28 and col. 30, lines 47-55 and lines 62-67 and col. 31, line[] 15); automatically creating a search string including the at least one trademark, tradename, celebrity name, and famous name based on the at least one trademark, tradename, celebrity name, and famous name entered by the user (see [F]ig. 28 and col. 31, lines 10-18 and lines 27-65); providing search results of identified matches corresponding to the search string in the contents of the Web page (col. 20, lines 47-55).

Farris also discloses the Web page on the Internet to be searched; and searching contents of the Web page received for matches in the contents of the Web page address (Internet address or domain name's address: col. 30, lines 57-62 and col. 32, lines 14-20; also see col. 29, lines 53-58).”

The Examiner noted that Farris does not teach searching of a web page based on a URL address. However, the Examiner took Official Notice that a person of skill in the art at the time of the invention would have known “to utilize the Internet address or domain name's address for display or getting the result of web page or tradename as taught by Farris because it would have made the method being efficiently and effectively to verify and identify the domain name as well as tradename in the InterNic (col. 15, lines 50-67) of the multiple search engines of the Internet network environment.” The Examiner further stated that it would have been obvious to combine

Farris and the Examiner's Official Notice in the direction of claims 1-3, 6-8, and 11-14.

Independent claim 1, as amended, recites (with emphasis added):

"A method of searching and reporting an incidence of at least one of a trademark, a tradename, a celebrity name, and a famous name in a Web page on the Internet, comprising:

entering, by a user, the at least one trademark, tradename, celebrity name, and famous name to be searched in the Web page on the Internet;
automatically creating a search string including the at least one trademark, tradename, celebrity name, and famous name based on the at least one trademark, tradename, celebrity name, and famous name entered by the user;
receiving a URL address of the Web page on the Internet to be searched;
accessing and searching contents of the Web page of the URL address received for matches in the contents of the Web page corresponding to the search string, wherein the searched contents includes elements other than a domain name; and
providing search results of identified matches corresponding to the search string in the contents of the Web page of the URL address."

Farris discloses an analysis and validation system for provisioning network-related facilities. Farris discloses "[e]ven though InterNIC clears domain names for use on the Internet, a search of trademarks and trade names used in the United States should also be performed." [Col. 30, lines 47-49.] Farris further teaches "[o]n the Internet, no trademark searches are done, and unlike other computer networks, such as America On-Line, CompuServe, and Prodigy, no central authority exists. Due to recent trademark infringement controversies, applications for domain names now require applicants to state that they have a commercial right to use the applied for name." [Col. 30, line 66 – col. 31, line 5.] Farris further discloses that if InterNic "receives evidence that a registered domain name is identical to that of a third party's registered trademark or service mark, the owner of the domain name must provide InterNic with a certified copy of its own federal trademark or service mark registration for the mark being used as the domain name." [Col. 31, lines 27-32.] Farris further discloses, in FIG. 28, a ready-to-serve (RTS) architecture used to provision various physical and logical

network architectures. “RTS 136 ... has access to various trademark/tradename databases for verification of user name availability.” [Col. 51, line 66 – col. 52, line 1.]

However, neither Farris nor the Examiner’s Official Notice, alone or in combination, disclose, teach, or suggest a method of searching and reporting an incidence of at least one of a trademark, a tradename, a celebrity name, and a famous name in a Web page on the Internet, including *accessing and searching contents of the Web page of the URL address received for matches in the contents of the Web page corresponding to the search string, where the searched contents includes elements other than only a domain name*. Farris is directed to a way of determining whether a *domain name* is the same as another party’s trademark. The only Internet-related content searched according to Farris is the domain name. Independent claim 1, as amended, on the other hand, specifies searching contents of a Web page, and the *searched contents includes elements other than only a domain name*. This is a significant difference. There are approximately 34 million registered domain names (see Exhibit A, Whois.net webpage), but there are *billions* of web pages. In fact, google.com alone has *indexed* over 3 billion web pages (see Exhibit B, “Search Engine Showdown” webpage). Moreover, applicants also note that Farris is not directed to accessing and searching contents of a Web page, as specified in independent claims 1, as amended. Instead, Farris is directed to searching a trademark database, not a Web page. Accordingly, applicants respectfully submit that the searching of the trademark database disclosed in Farris is irrelevant to the accessing and searching contents of a *Web page* specified in independent claim 1, as amended.

The method specified by independent claim 1, as amended, provides for the

searching of such contents of the Web pages other than only a domain name.

Accordingly, the search according to independent claim 1 is far more exhaustive than a mere search of just domain names, as taught by Farris. Web pages typically include tradenames, trademarks, famous names, etc., located in contents other than in the domain name. Therefore, independent claim 1, as amended, distinguishes over Farris, alone or in combination with the Examiner's Official Notice.

Claims 2-4 and 17 all directly depend from independent claim 1, as amended, and therefore also distinguish over Farris, alone or in combination with Official Notice, for the same reasons as those set forth above with respect to independent claim 1, as amended. Independent claims 5, 6, 10, 12, and 16, each as amended, contain limitations similar to those of independent claim 1, as amended, and therefore also distinguish over Farris, alone or in combination with Official Notice, for reasons similar to those set forth above with respect to independent claim 1, as amended. Claim 18 directly depends from independent claim 5, as amended, and therefore also distinguish over Farris, alone or in combination with Official Notice, for the same reasons as those set forth above with respect to independent claim 5, as amended. Claims 7-9, 11, and 19 directly depend from independent claim 6, as amended, and therefore also distinguish over Farris, alone or in combination with Official Notice, for the same reasons as those set forth above with respect to independent claim 6, as amended. Claims 13-15 directly depend from independent claim 12, as amended, and therefore also distinguish over Farris, alone or in combination with Official Notice, for the same reasons as those set forth above with respect to independent claim 12, as amended. Claim 20 directly depends from independent claim 16, as amended, and therefore also

distinguish over Farris, alone or in combination with Official Notice, for the same reasons as those set forth above with respect to independent claim 16, as amended.

Claims 4, 9, and 15 were rejected under 35 U.S.C. §103(a) as being obvious over Farris, in view of Weinberg. The Examiner noted that Farris does not "indicate the trademark, trade name, celebrity name, and famous name found in the web page being highlighted." However, the Examiner stated that Weinberg disclosing the highlighting of text and that it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Farris and Weinberg in the direction of claims 4, 9, and 15.

As stated above claims 4, 9, and 15 distinguish over Farris. Weinberg does not make up for the deficiencies of Farris. Representative claim 4 directly depends from independent claim 1, as amended, and therefore incorporates by reference all limitations thereof. Weinberg discloses a visual Web site analysis program, implemented as a collection of software components, that provides a variety of features for facilitating the analysis and management of Web sites and Web site content. However, Weinberg does not disclose, teach or suggest, alone or in combination with Farris, a method of searching and reporting an incidence of at least one of a trademark, a trade name, a celebrity name, and a famous name in a Web page on the Internet, including *accessing and searching contents of the Web page of the URL address received for matches in the contents of the Web page corresponding to the search string, where the searched contents includes elements other than a domain name.* Accordingly, claim 4 distinguishes over Farris and Weinberg in combination. Claims 9 and 15 contain limitations similar to those of claim 4 and therefore also distinguish over

Farris and Weinberg, in combination, for reasons similar to those set forth above with respect to claim 4.

Claims 5, 10, and 16 were rejected under 35 U.S.C. §103(a) as being obvious over Farris, in view of Siegel. The Examiner noted that Farris does not "indicate that the sound or spelling of the at least one trademark, tradename, celebrity name, and famous name entered by the user." However, the Examiner stated that Siegel discloses a talking database and dictionary database including a plurality of words and distribution of the sounds of them, and that it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine the teachings of Farris and Siegel in the direction of claims 5, 10, and 16.

As stated above claims 5, 10, and 16 distinguish over Farris. Representative claim 5 directly depends from independent claim 1, as amended, and therefore incorporates by reference all limitations thereof. Siegel does not make up for the deficiencies of Farris. Siegel discloses a method of navigating textual information via auditory indicators. However, Siegel does not disclose, teach or suggest, alone or in combination with Farris, a method of searching and reporting an incidence of at least one of a trademark, a trade name, a celebrity name, and a famous name in a Web page on the Internet, including *accessing and searching contents of the Web page of the URL address received for matches in the contents of the Web page corresponding to the search string, where the searched contents includes elements other than a domain name*. Accordingly, claim 5 distinguishes over Farris and Siegel in combination.

Claims 10 and 16 contain limitations similar to those of claim 5 and therefore also distinguish over Farris and Weinberg, in combination, for reasons similar to those set

forth above with respect to claim 5.

Moreover, new claims 17-20 further distinguishes over Farris, alone or in combination with Weinberg and/or Siegel. Specifically, representative new claim 17 recites (with emphasis added): “[t]he method of searching and reporting according to claim 1, **wherein the searched contents includes at least two of the following portions of the Web page: a domain name, a meta tag, hidden text, titles, and images.**” None of Farris, Weinberg, or Siegel disclose such searching and reporting, where the searched contents include at least two of such portions of the Web page. As discussed above, Farris teaches a method to determine whether a *domain name* is the same as another party’s trademark. But Farris does not, alone or in combination with Weinberg and/or Siegel disclose searching *at least two* of the following portions of the Web page: a domain name, a meta tag, hidden text, titles, and images. Therefore, new claim 17 further distinguishes over Farris, alone or in combination with Weinberg and/or Siegel. New claims 18-20 contain limitations similar to those of new claim 17 and therefore also distinguish over Farris, alone or in combination with Weinberg and/or Siegel for reasons similar to those set forth above with respect to new claim 17.

Accordingly, for the reasons above, applicants respectfully submit that the rejection of claims 1-16 under 35 U.S.C. §103(a) should be withdrawn.

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Applicants believe that the foregoing amendments place the application in condition for allowance, and a favorable action is respectfully requested. If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call either of the undersigned attorneys at the Los Angeles telephone number (213) 488-7100 to discuss the steps necessary for placing the application in condition for allowance should the Examiner believe that such a telephone conference would advance prosecution of the application.

Respectfully submitted,

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Exhibit A

Whois.NetSM

DOMAIN-BASED RESEARCH SERVICES

Domain Name Statistics:
 34,034,756 domains registered
 2,942,092 deleted domains
 1,739,468 domains on-hold

August 25th, 2003

Use this Whois Tool to:

verio

Explanation of Tool:

WHOIS Lookup



Lookup registration data for domains.

Search by domain or keyword



Search domains and lookup whois information. Research and protect trademarks.

Get your own Domain Name



Find available domains.

Search through deleted domains



Find previously registered domains that are now available.

Domain Information

[Pricing](#), [Suggest-A-Name](#), [News](#)
[Domain Monitoring](#), [ICANN](#)

Hosting Resources

[Web Plans](#), [E-Commerce](#), [Custom Websites](#)
[VPS](#), [Managed Hosting](#), [Reseller Programs](#)

Trademark / Intl Info

[US](#), [EU](#), [Canada](#), [UK](#), [Japan](#), [WIPO](#)
[INTA](#), [Free TM Search](#), [Babel Fish](#)

WHOIS Resources

[Domain Names](#): [WHOIS](#), [AllWhois](#), [Intl TLDs](#)
[IP Addresses](#): [ARIN](#), [RIPE NCC](#), [APNIC](#)

[Register A Domain Name & Win \\$50,000!](#)

How can I get my own Domain Name?

What is a Domain name?

How do I set up a Web Site?

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NTT/VERIO

Search Engine Showdown

The Users' Guide
to Web Searching

Win \$35,000 towards
your house...



[Home](#) [Chart](#) [Reviews](#) [Statistics](#) [Learn](#) [Directories](#) [Search](#)

Search Engine Statistics: Database Total Size Estimates

by Greg R. Note

Search Engine	Showdown Estimate (millions)	Claim (millions)	Data from: Dec. 31, 2002
Google	3,033	3,083	Based on AlltheWeb reported size and percentages from relative size showdown
AlltheWeb	2,106	2,112	AlltheWeb: 2,106,156,957 reported
AltaVista	1,689	1,000	
WiseNut	1,453	1,500	
Hotbot	1,147	3,000	
MSN Search	1,018	3,000	
Teoma	1,015	500	
NLResearch	733	125	
Gigablast	275	150	

The table above gives the Showdown Estimate and recent claims as to how many millions of Web pages have been indexed and included in the various search engines' databases. These estimates are based on exact counts obtained from AlltheWeb on the date of the comparison, and those numbers are multiplied by the percentage of a search engine's total hits from the searches used on the Relative Size Showdown as compared to the number found by AlltheWeb. The Showdown Estimate is then an average of those two numbers. It aims to give the searcher a very approximate estimate of the **effective size** of the database -- the part of the database from which the searcher may actually see results. While the terms used for the Relative Size Showdown searches are not chosen completely at random, they were chosen from a variety of subject areas and countries so as to meet the criteria outlined in the methodology.

AlltheWeb provided me with a technique (which unfortunately I am not permitted to disclose) which gives an exact count of the records in their database, even though that does differ from their published claim on the front page of their site.

So why these discrepancies between claimed size and the Showdown Estimates? Bear in mind that these are very rough estimates and that they are based on actual search results. There are several factors to consider which may explain these results beyond the limit of basing the estimates on a small number of searches and on only AlltheWeb's reported numbers.

The Inktomi-based search engines such as Hotbot are run on clusters of computers. According to Inktomi, at any point in time, some of the computers may be down for backup or other maintenance. Consequently, their entire database may not be searched at any point in time. In addition, Inktomi partners may choose to only use certain slices of the database. My estimates thus reflect what was available to be searched at the time the searches were run. If Inktomi and others do not have their full databases available to searchers, what is the use of that extra size if it is inaccessible? These estimates may well give a better sense of the size of the accessible portion of the search engine databases.

Google claims over 3 billion pages in its index, but only some of those are fully indexed, with the rest being non-indexed URLs. These only rarely show up in search results and while the numbers here include them, it is less than 1% of their results. NLResearch and Gigablast are at such a significant size difference that this method does not give a fair estimate of their size, and the numbers listed under the claim column are probably much closer to their true numbers. In general, the Relative Size Showdown gives a better comparison that is more statistically useful than this one, but people always like to see estimated numbers for the total size, so I provide this as well.

This total size comparison only covers the top search engines (as measured by database size) that were also included in the Relative Size Showdown.

See also the previous Total Size Estimates:

Mar. 2002
Aug. 2001
Apr. 2001
Oct. 2000
July 2000
Feb. 2000
Nov. 1999
Sept. 1999
Aug. 1999
May 1999
March 1999
Jan. 1999

While decisions about which Web search engine to use should not be based on size alone, this information is especially important when looking for very specific keywords, phrases, and areas of specialized interest. See also the following statistical analyses:

- Relative Size of the search engines
- Freshness, or how up-to-date the record in the database are
- Overlap between the search engines
- Unique Hits hits from each
- Dead Links comparison
- Change Over Time